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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,995	10/30/2003	Atul Navinchandra Parikh	309J-000740US	8835
22798	7590	02/11/2005	EXAMINER	
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.			PADGETT, MARIANNE L	
P O BOX 458			ART UNIT	
ALAMEDA, CA 94501			PAPER NUMBER	

1762

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,995

Applicant(s)

PARIKH ET AL.

Examiner

Marianne L. Padgett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-140 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to a process for UV patterning a lipid bilayer, classified in class 427 or 264 subclass (553 or 2.11+) or 405+, respectively.
 - II. Claims 19-40 & 42-63, drawn to a process for localized coating of UV patterned lipid bilayers, classified in class 553, subclass 553 or 2.11+.
 - III. Claims 18 & 98-99, drawn to a patterned lipid bilayer, classified in class 428, subclass 156+ or 195+.
 - IV. Claims 41, 64, 77-97, 100-140 drawn to a lipid bilayer with localized regions of a 2nd lipid bilayer within it or a kit employing this lipid bilayer, used for detecting or classifying environmental "moieties, such as bacteria, virus, fungus, a chemical agent, etc, classified in class 435, subclass 5 (possibly).
 - V. Claims 65-70 drawn to apparatus or kits for making patterned lipid bilayers classified in class 118, subclass 620.
 - VI. Claims 71-76 drawn to a kit for patterning lipid bilayer membranes classified in class 206, subclass 223 (569).

2. The inventions are distinct, each from the other because:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the claims of group II require deposition of a second lipid bilayer material within the UV patterned areas of the first lipid bilayer. The subcombination has separate utility such as it may be used without the second bilayer or refunctionalization as indicated in

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[0002] of the specification. Also the claims of group I are inclusive of the UV patterned areas +non-lipid areas, so maybe vacant or any material that is not or no longer a lipid.

3. Inventions (I or II) and (III or IV, respectively) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products can be made by alternate patterning techniques, such as electron beams or IR lasers or UV direct write processes, such as ones using a light beam/laser.

4. Inventions (I or II) and V are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process (MPEP § 806.05(e)). In this case, what material is treated by an apparatus, is a method limitation, thus not necessarily limiting to its structure & the apparatus may be used for treating membranes or films other than lipids. Note that the statutory class of this set of claims may be considered ambiguous, since a “system” and a “kit” may be different statutory classes, where the former frequently means apparatus. In this set of claims the various limitations are most consistent with an apparatus, however clarified to definitely be a kit, they might be recombined with group VI, which is most consistent with a kit, but presently they can be considered different inventions, one an apparatus & the other a kit that can both be employed in making the same product, where the apparatus can also make different products by use of different substrates being treated.

5. Inventions V and (III or IV) are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different

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apparatus (MPEP § 806.05(g)). In this case the logic is analogous to the above section 4, where the apparatus may use different source materials.

6. Inventions VI and (I or II) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the kit of group VI can be used in the processes of either I or II which have different end results as seen above in section 2.

7. Inventions VI and (III or IV) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a kit for producing patterned lipid bilayers with or without a second lipid bilayer material localized within and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I or II is not required for Group III or IV or V or V, etc, restriction for examination purposes as indicated is proper.

9. A telephone call was made to Paul Littlepage on 2/3/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

On 2/9/05, Mr. Littlepage called back & asked for the restriction to be mailed as the applicants wanted more time to decide.

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

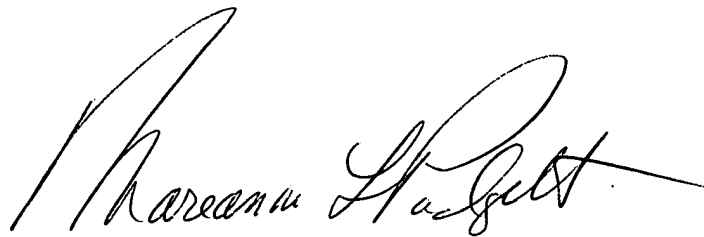
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck, can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLP 2/3/05 & 2/9/05

A handwritten signature in black ink, appearing to read "Marianne Padgett". The signature is fluid and cursive, with a large initial "M" and a long, sweeping underline.

MARIANNE PADGETT
PRIMARY EXAMINER